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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

		Application Number	10/731,173
		Filing Date	December 8, 2003
		First Named Inventor	Shawn W. O'Driscoll
		Art Unit	3732
		Examiner Name	Candice Capri Stokes
Total Number of Pages in This Submission	18	Attorney Docket Number	ACM 340US

### ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
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Remarks		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Kolisch Hartwell, P.C.		
Signature			
Printed name	James R. Abney		
Date	February 12, 2007	Reg. No.	42,253

### CERTIFICATE OF TRANSMISSION/MAILING

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Signature			
Typed or printed name	Christina Rainey	Date	February 12, 2007

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# FEE TRANSMITTAL

## For FY 2005

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

500.00

## Complete if Known

Application Number	10/731,173
Filing Date	December 8, 2003
First Named Inventor	Shawn W. O'Driscoll
Examiner Name	Candice Capri Stokes
Art Unit	3732
Attorney Docket No.	ACM 340US

## METHOD OF PAYMENT (check all that apply)

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## FEE CALCULATION

## 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

## 2. EXCESS CLAIM FEES

## Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Small Entity Fee (\$)	Fee (\$)
- 20 or HP =	x	=		50	25

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	x	=				

HP = highest number of independent claims paid for, if greater than 3.

## 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x		

## 4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief Fee (\$500) Fees Paid (\$)

500

## SUBMITTED BY

Signature	<u>James R. Abney</u>	Registration No. 42,253 (Attorney/Agent)	Telephone (503) 224-6655
Name (Print/Type)	James R. Abney		Date February 12, 2007

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Date: February 12, 2007

SHAWN W. O'DRISCOLL and DAVID G. JENSEN

Serial No. : 10/731,173 Examiner Candice Capri Stokes  
Filed : December 8, 2003 Group Art Unit 3732  
For : BONE PLATES

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Alexandria, Virginia 22313-1450

Sir:

## **APPEAL BRIEF OF APPELLANTS**

This Brief is presented in opposition to the Examiner's rejection of claims 3, 9-14, and 31-35 in the final Office action dated September 12, 2006.

## I. REAL PARTY IN INTEREST

The real party in interest is Acumed LLC, a limited liability company established under the laws of Delaware and having a place of business at 5885 NW Cornelius Pass Road, Hillsboro, Oregon.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no known related appeals or interferences.

### **III. STATUS OF CLAIMS**

The status of every claim is as follows: claims 1, 2, 4–8, and 15–30 are canceled; and claims 3, 9–14, and 31–35 are under final rejection.

Rejected claims 3, 9–14, and 31–35 are the claims at issue in this appeal.

**IV. STATUS OF AMENDMENTS**

No amendments to the claims have been made subsequent to the final Office action dated September 12, 2006. (The most recent amendments to the claims were introduced by the Response to Office Action dated June 22, 2006.)

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The summary is set forth in exemplary embodiments. Discussion about elements and recitation of claimed subject matter can be found at least at the locations in the specification and drawings cited below.

The claims at issue in this appeal are directed to a set for bone fixation (e.g., page 2, lines 18 and 19). The set comprises at least three bone plates having different shapes (e.g., Figures 1–48). At least a pair of the bone plates are configured to be secured to the same left or right half of a skeleton and include the same color (e.g., Figures 1–3 and page 8, lines 4–10). At least one other of the bone plates is configured to be secured to the other half of a skeleton and includes a distinct color, thereby providing a two-color system for distinguishing left bone plates from right bone plates (e.g., page 8, lines 4–10).

Specific references to portions of the application are provided with the understanding that nonreferenced portions of the application also may be relevant. Accordingly, the claims are not limited by the particular references made above, but rather are fully supported by the entirety of the disclosure.

## **VI. GROUNDS OF REJECTION**

Appellants are appealing the following grounds of rejection:

- Claims 3, 12–14, and 31–35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,592,578 to Henniges et al. (“Henniges”);
- Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Henniges in view of U.S. Patent No. 4,565,193 to Strelí (“Strelí”); and
- Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Henniges in view of U.S. Patent No. 6,623,486 to Weaver et al. (“Weaver”).

## **VII. ARGUMENT**

The Examiner has improperly rejected appellants’ claims 3, 9–14, and 31–35 under 35 U.S.C. § 103(a) over Henniges alone or in combination with Strelí or Weaver. When the claims are reviewed under the current standards for obviousness as set by the Federal Circuit Court of Appeals and the Board of Patent Appeals and Interferences, the impropriety of the rejections becomes clear.

### **A. STANDARD OF REVIEW**

Obviousness is a question of law based on (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.” *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled

to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The Manual of Patent Examining Procedure sets forth three basic criteria that must be met to establish a *prima facie* case of obviousness (MPEP § 2143 (emphasis added)):

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Teachings in a reference indicating that a proposed combination should not be made must be considered when determining whether there is a motivation to make the proposed combination. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). For example, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, the proposed modification cannot change the principle of operation of a reference. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The law is "clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re*

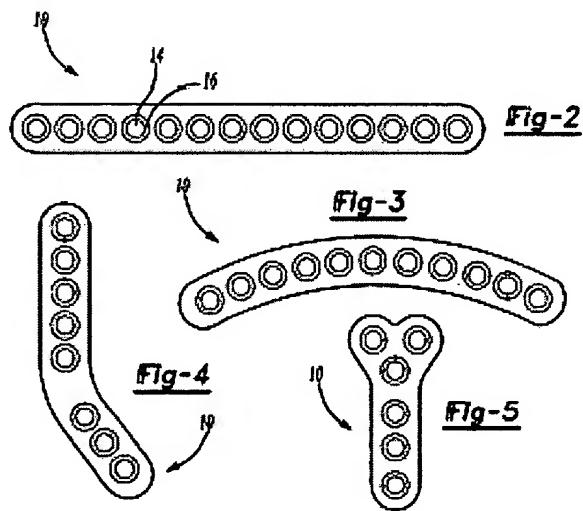
Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted).

### B. The Cited References

The Examiner relied on Henniges, Streli, and Weaver for rejection of the claims. This subsection briefly summarizes the disclosures of these references and their relation to the claimed invention.

#### B.i Henniges

Henniges relates to bioabsorbable bone plates. The bone plates are disclosed to have a rigid state and a deformable state produced from the rigid state by heating the bone plates. In the deformable state, the bone plates can be deformed according to the contours of particular bones being repaired. The bone plates of Henniges are manufactured as generic plates, as illustrated in Figures 2–5 of Henniges, which are reproduced here to facilitate review:



Henniges also discloses, as an additional feature, the bone plates being color-coded "for easy identification during a surgical procedure" (col. 6, lines 44–46). In particular, Henniges states "by manufacturing the plates 10 with a unique color

associated with each unique shape and size, confusion will be minimized and time will be saved" (col. 6, lines 49–51; emphasis added). In other words, Henniges discloses that each unique plate (i.e., with a unique shape and size) should have its own unique color to allow the various unique plates to be distinguished from one another, to minimize confusion and save time. Accordingly, the color-coding approach disclosed by Henniges uses distinct colors to distinguish a pair of distinct bone plates, whether the plates of the pair are configured for use on the same (left or right, not both) half of the skeleton, on different (respective left and right) halves of the skeleton, or each on both (left and right) halves of the skeleton.

B.ii    Streli

Streli is not relevant to the use of color with bone plates. Streli relates to pronged bone plates and includes no disclosure related to any use of color.

B.iii    Weaver

Weaver, like Streli, is not relevant to the use of color with bone plates. Weaver relates to a bone plating system with locking and non-locking holes and screws and includes no disclosure related to any use of color.

C. INDEPENDENT CLAIM 34 AND DEPENDENT CLAIMS 3, 9–14, 31–33, and 35

Independent claim 34 reads as follows:

34. A set for bone fixation, comprising:

at least three bone plates having different shapes, at least a pair of the bone plates being configured to be secured to the same left or right half of a skeleton and including the same color and at least one other of the bone plates being configured to be secured to the other half of a skeleton and including a distinct color, thereby providing a two-color system for distinguishing left bone plates from right bone plates.

The Examiner rejected claim 34 under 35 U.S.C. § 103(a) as being unpatentable over Henniges. However, as set forth below, appellants contend that the claimed invention is not obvious over Henniges because there is no motivation to modify Henniges to achieve the claimed invention.

In the most recent Office action (dated September 12, 2006), the Examiner stated that "Henniges et al teach the claimed invention except for the distinct color indicating a left or right half of the skeleton" (page 3, lines 11 and 12; emphasis added). Accordingly, consistent with a rejection based on obviousness rather than anticipation, the Examiner admitted that Henniges does not teach or suggest every element of claim 34. The Examiner then asserted it "would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a color coded method for identifying [ ] each plate as taught by Henniges et al in order to minimize confusion during a surgical procedure" (page 3, lines 13-16). However, the color-coding approach of Henniges is very different than that used by the set of the claimed invention and must be modified substantially in order to produce the claimed invention. The Examiner has not established a *prima facie* case of obviousness because the Examiner has not met the Examiner's burden of providing a teaching, suggestion, or motivation for modifying the disclosure of Henniges according to the claimed invention. The Examiner apparently suggests that the modification would be obvious "to minimize confusion during a surgical procedure." However, the color coding approach of Henniges is disclosed as minimizing confusion already, without modification, so there is no motivation to substantially modify the color coding approach of Henniges to achieve the invention of claim 34.

Appellants also submit that it would not have been obvious to modify the color coding approach of Henniges to achieve the claimed invention because Henniges discloses a color-coding approach that is incompatible with and thus teaches away from the two-color system recited by claim 34. Henniges teaches that each unique plate (i.e., each plate with a unique shape and size) should have its own unique color to allow the various unique plates to be distinguished from one another, to minimize confusion and save time. However, claim 34 recites a pair of bone plates including the same color and having different shapes. Henniges thus teaches away from the set of bone plates of claim 34, because Henniges implies that plates of different shape and the same color would create confusion and waste time in the operating room. Therefore, for this additional reason, it would not have been obvious to modify Henniges to achieve the invention of claim 34.

In summary, claim 34 is not obvious over Henniges because the Examiner has not established a *prima facie* case of obviousness. In particular, the Examiner has not provided any teaching, suggestion, or motivation for modifying the color-coding approach of Henniges to achieve the claimed invention. Moreover, appellants maintain that Henniges teaches away from the modification that would have been required to achieve the claimed invention. Claim 34 thus should be allowed. Claims 3, 9–14, 31–33, and 35, which depend from claim 34, also should be allowed for at least the same reasons as claim 34.

#### D. CONCLUSION

Appellants assert that there is no *prima facie* case of obviousness for rejection of any of the pending claims, for at least the reasons stated above. In particular, the cited

references, alone or in combination, do not teach or suggest every element of any of the claims, and there is no teach, suggestion, or motivation to modify the cited references to achieve the claimed invention. Accordingly, appellants maintain that the rejection of claims 3, 9–14, and 31–35 under 35 U.S.C. § 103(a) over the cited references is improper.

VIII. CLAIMS APPENDIX

3. (Previously Presented) The set of claim 34, further comprising at least one other bone plate configured for use on each of the left half and the right half of a skeleton, the at least one other bone plate including a color that is distinct from the two-color system of the at least three bone plates.

9. (Previously Presented) The set of claim 34, wherein each bone plate is configured to be secured to a distal region of a humerus bone or a proximal region of an ulna bone.

10. (Previously Presented) The set of claim 34, wherein at least one of the at least three bone plates includes at least one prong configured to engage bone when the bone plate is secured to bone.

11. (Previously Presented) The set of claim 34, wherein at least one of the at least three bone plates has a first portion configured to be secured adjacent an end of a long bone and a second portion configured to be secured toward or on a shaft of the long bone, and wherein the first portion of the at least one bone plate is thinner on average than the second portion of the at least one bone plate.

12. (Previously Presented) The set of claim 34, wherein at least one of the at least three bone plates includes a curved bone-facing surface configured to match the curved contour of a distinct bone region to which the at least one bone plate is configured to be secured.

13. (Previously Presented) The set of claim 34, further comprising instructions that relate each bone plate to the left half or the right half to which the bone plate is configured to be secured.

14. (Previously Presented) A method of bone fixation, comprising:  
selecting a left half or a right half of a skeleton for fixation;  
selecting one of the at least three bone plates of claim 34 having a color that corresponds to the selected left or right half; and  
securing the one bone plate to the selected left or right half.

31. (Previously Presented) The set of claim 34, wherein the at least three bone plates include a pair of bone plates configured to be secured to corresponding bones of the left half and the right half of a skeleton.

32. (Previously Presented) The set of claim 34, wherein the at least three bone plates include a pair of bone plates configured to be secured to noncorresponding bones of the left half and the right half of a skeleton.

33. (Previously Presented) The set of claim 34, wherein each bone plate configured for the left half of a skeleton is blue, and wherein each bone plate configured for the right half of a skeleton is green.

34. (Previously Presented) A set for bone fixation, comprising:  
at least three bone plates having different shapes, at least a pair of the bone plates being configured to be secured to the same left or right half of a skeleton and including the same color and at least one other of the bone plates being configured to be secured to the other half of a skeleton and including a distinct color, thereby providing a two-color system for distinguishing left bone plates from right bone plates.

35. (Previously Presented) The set of claim 31, wherein the pair of bone plates configured to be secured to corresponding bones are shaped as mirror images of one another.

**IX. EVIDENCE APPENDIX**

None.

**X. RELATED PROCEEDINGS APPENDIX**

None.

CERTIFICATE OF MAILING

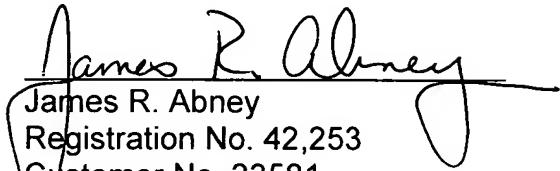
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Christina Rainey

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Respectfully submitted,

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